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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,457	10/16/2003	Kok Boon Heh	P-5241C1	8732

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,457

Applicant(s)

HEH ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims as amended include the limitation “a body member for insertion into a patient”. However, the specification contains no description of inserting the body member (30) into a patient.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 3 and 5 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,484,419 to Fleck in view of U.S. Patent No. 5,730,150 to Peppel et al., and further in view of U.S. Patent No. 6,213,375 to Rybicki.

In regards to claims 1 – 3 and 5 - 16, Fleck discloses a guidewire advancer (Figure 1) having an elongate tube (14) with a first outlet at a first end and a second outlet at a second end (Col. 4, lines 7 – 8); a guidewire (16) slidably disposed within the elongate tube (14); a body member (Figure

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3) fully capable of insertion into a patient having a proximal portion (22), a central portion adapted to receive a finger of a caregiver (Col. 4, lines 24 – 26) and a distal portion (13), wherein the proximal portion is connected to the first outlet of the elongate tube (Col. 4, lines 3 – 5); the proximal portion defines a passage (24) therein for allowing a guidewire to extend therethrough; the distal portion defines a passage therein for allowing a guidewire to extend therethrough; the body member (Figure 3) includes a slot (28) adapted to hold the guidewire in a coiled position (Col. 4, lines 46 – 49); and an end cap (18) covering the second outlet of the elongate tube. However, Fleck fails to disclose the passage of the proximal portion of the body member being above the passage of the distal portion of the body member. Fleck also fails to disclose a roller wheel having a circumferential rough surface positioned adjacent the central portion of the body member having a top portion exposed at the top of the body member and having an axis below the passage of the proximal portion of the body member. Peppel et al. discloses a guidewire advancer (Figure 2) wherein the passage of the proximal portion of the body member is above the passage of the distal portion of the body member (Col. 3, lines 59 – 62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the proximal passage as disclosed by Fleck to lie above the distal passage as taught by Peppel et al. in order to provide a braking effect to allow the guidewire to be retained within the elongated tube (Col. 3, lines 62 – 65). Rybicki discloses a wire advancer having a roller wheel (18) with a circumferential rough surface (18A; Col. 3, line 35) positioned adjacent the central portion of the body member (12) having a top portion exposed at the top of the body member (Figure 2) and having an axis below the passage (20) of the proximal portion of the body member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guidewire advancer as disclosed by

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Fleck in view of Peppel et al. to include a roller wheel as taught by Rybicki to allow the caregiver the ability to advance the guidewire at a steady rate (Col. 3, lines 63 – 64).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,484,419 to Fleck in view of U.S. Patent No. 5,730,150 to Peppel et al., and U.S. Patent No. 6,213,375 to Rybicki as applied to claim 1 above, and further in view of U.S. Patent No. 4,381,777 to Garnier.

In reference to claim 4, Fleck in view of Peppel et al. and Rybicki discloses the circumferential surface of the roller wheel (18) having a rough surface (18A). However, Fleck in view of Peppel et al. and Rybicki does not disclose this surface being rubberized. Garnier teaches forming a roller wheel out of rubber (Col. 3, lines 13 – 17). It would have been obvious to one having ordinary skill in the art to replace the rough surface as disclosed by Fleck in view of Peppel et al. and Rybicki with one that is rubberized as taught by Garnier in order to increase the coefficient of friction between the roller wheel and the guide wire. Furthermore, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Response to Arguments

Applicant's arguments filed 4/18/05 have been fully considered but they are not persuasive. Applicant has asserted that the prior art in combination fails to disclose a body member for insertion into a patient being connected to a roller wheel. However, the Examiner disagrees. The Examiner has established a *prima facie* case of obviousness as to why one having ordinary skill in the art at the time the invention was made would have been motivated to modify the body member as disclosed by Fleck in view of Peppel et al. to include a roller wheel as taught by Rybicki. The proximal portion (22) of the body member as disclosed by Fleck in view of Peppel et al. and further in view of

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Rybicki is fully capable of insertion into a patient. Furthermore, a recitation with respect to the manner in which an apparatus is intended to be employed, i.e. for insertion into a patient, does not impose any structural limitation upon the claimed apparatus that differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1947); *In re Yanush*, 477 F.2d 958, 177 USPQ705 (CCPA 1973); *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963); *Ex parte Masham*, 2 USPQ2d 1647 (BbPatApp & Inter 1987).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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